

Remarks

Applicants have carefully reviewed the Office Action mailed on June 14, 2005. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Please cancel claims 7, 9-16, 19, 27-29, 32, 37-38, and 40-44 without prejudice. With this amendment, claims 1, 8, 17, 20, 21, 30, 33, 34, 39, and 45 are amended. Claims 1-6, 8, 17-18, 20-26, 30-31, 33-36, 39, and 45 remain pending.

Claims 1-7 and 9-45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Turovsky et al. in U.S. Patent Publication No. US 2002/0128679 in view of Gillick et al. in U.S. Patent No. 6,755,854. Please note that claims 7, 9-16, 19, 27-29, 32, 37-38, and 40-44 are cancelled. Regarding claims 1-6, claim 1 is amended to recite that the button is longitudinally movable along a line that is parallel to the longitudinal axis of the sheath. Neither Turovsky et al. nor Gillick et al. appear to teach or disclose all of the limitations of amended claim 1. Turovsky et al. fails to disclose the claimed actuator assembly coupled to the proximal end of the outer sheath and capable of moving the outer sheath relative to the inner shaft. Instead, the "actuator" of Turovsky et al. is attached to the "inner shaft". Gillick et al. disclose an actuating system that uses motion that follows a line that is at an angle to the line of motion of the restraining sheath. Gillick et al. at column 3, lines 29-59. Therefore, not only does Gillick et al. fail to teach or disclosed the claimed actuator assembly, Gillick et al. teaches away from using a button that is longitudinally movable along a line that is parallel to the longitudinal axis of the sheath. Accordingly, amended claim 1 is believed to be patentable over the combination of Turovsky et al. and Gillick et al. Because claims 2-6 depend from claim

1, they are also patentable based on this amendment and because they add significant elements to distinguish them further from the art.

Regarding claims 17-18, claim 17 is amended into independent form. Claim 17 recites that the button is axially rotatable. None of the "buttons" disclosed by Gillick et al. appear to rotate in any manner or fashion. MPEP §2143 states that in order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested. Even if the Examiner believes that rotational movement would be an obvious alternative design choice, the combination of cited references fails to disclose all of the claim limitations. In order for the Examiner to establish a *prima facie* case of obviousness, the Examiner must either provide a reference that teaches or discloses the claimed feature or provide evidentiary support for the fact that buttons that are axially rotatable are well-known in the art and are "capable of instant and unquestionable demonstration as being well-known". MPEP §2143.03. Without such evidence, a *prima facie* case of obviousness is not properly established for claim 17. Based on these remarks, Applicants respectfully submit that claim 17 as well as claim 18 depending therefrom are in condition for allowance and should be allowed in due course.

Regarding claim 20, this claim is amended into independent form and recites that the actuator assembly includes a second button and a second gear and that pressing the second button moves the outer tube in a direction that is opposite to pressing the first button. The Examiner indicated that "providing a second actuator going in the opposite direction on the distal side of the gear 44 in order to actuate the gear in the opposite direction is a mere duplication of known parts." A duplication of parts that does not produce anything new is, in fact, not sufficient to provide patentable significance to a

claim. See MPEP §2144.04-VI.B. However, in the instant case, the second button and second gear are being provided to provide a significant and different feature from the first button. In fact, pressing the second button moves the sheath in the opposite direction than the first button. Applicants respectfully submit that a structural limitation that provides a different, and indeed opposite, result is not a mere duplication of parts. Accordingly, the features recited in claim 20 carry patentable significance. Because the cited references fail to disclose these features, claim 20 is believed to be in condition for allowance.

Regarding claim 21-26 and 30-31, claim 21 is amended to recite that the button is rotatable. For the same reasons as what is set forth above with respect to rotatable buttons not being shown or taught by the cited references, Applicants respectfully submit that amended claim 21 is distinguishable from the cited references and in condition for allowance. Because claims 22-26 and 30-31 depend from amended claim 21, they are also patentable based on this amendment and because they add significant elements to distinguish them further from the art. Please note that claim 30 is amended to correct its dependency in light of the cancellation of claim 27.

Regarding claim 33, this claim is amended into independent form and recites a second gear and a second button, and that pressing the second button moves the outer tube in a direction that is opposite to pressing the button. For the same reasons as what is set forth above with respect to these features, Applicants respectfully submit that claim 33 is patentable over the cited references.

Regarding claims 34-36, claim 34 is amended to recite that the actuator assembly includes a gear, the gear is engageable with the proximal tubular member, the actuator

assembly further comprises a button coupled to the gear and wherein the step of actuating the actuator assembly includes pressing the button, the actuator assembly further comprises a second gear and a second button coupled to the proximal tubular member and wherein the step of actuating the actuator further comprises pressing the second button, and that pressing the second button moves the outer tube in a direction that is opposite to pressing the button. None of the cited references appear to disclose, for example, the step of pressing the second button where pressing the second button moves the outer tube in a direction that is opposite to pressing the button. Accordingly, amended claim 34 is believed to be in condition for allowance. Because claims 35-36 depend from amended claim 34, they are also patentable based on this amendment and because they add significant elements to distinguish them further from the art.

Regarding claim 39, this claim is amended into independent form and recites that the step of actuating the actuator assembly further comprises rotating a thumbwheel coupled to the gear. None of the cited references appear to disclose or teach this step. Accordingly, claim 39 is believed to be patentable over the cited references.

Regarding claim 45, this claim is amended into independent form and recites that the step of actuating the actuator assembly includes axially rotating a button and wherein rotating the button results in movement of the outer sheath relative to the inner shaft. None of the cited references appear to disclose or teach this step. Accordingly, claim 45 is believed to be patentable over the cited references.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims. Claim 8 is now amended into independent form.

Applicants respectfully submit that this amendment overcomes the objection.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

THOMAS DEYETTE, JR., ET AL.

By Attorney,

Date: Sept. 14, 2005

Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050